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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22

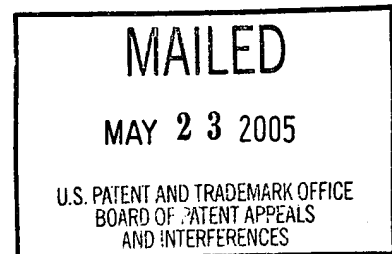
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY RICHARD CAVILL AND WILLIAM HENRY REED

Appeal No. 2005-0456
Application No. 09/610,404

ON BRIEF



Before BARRETT, RUGGIERO, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-20, which are all of the claims pending in this application.

We REVERSE.

Appellants' invention relates to an apparatus and method for data management within a photoprinter. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of processing a digital photographic image on a photoprinter, comprising:
 - receiving a digital photographic image in a first format on a printer;
 - performing one or more first operations on the digital photographic image in the first format;
 - converting the digital photographic image to a second format; and
 - performing one or more second operations on the digital photographic image in the second format.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Levine	4,751,583	Jun. 14, 1988
Chang et al. (Chang)	4,965,748	Oct. 23, 1990
Itoh	6,034,785	Mar. 7, 2000

Claims 1, 3-5, and 7-20 stand rejected under 35 U.S.C. § 102 as being anticipated by Itoh. Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Itoh in view of Chang. Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Itoh in view of Levine.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No.17, mailed Jun. 2, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 16, filed Mar. 11, 2003) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984), it is only necessary for the claims to "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the

reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. **See Studiengesellschaft Kohle v. Dart Indus., Inc.**, 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

The examiner maintains that Itoh teaches every element of the claimed invention. Appellants argue that Itoh does not teach the claimed method and apparatus for processing a digital image on a photoprinter, as defined in appellants' specification. Appellants argue that the specification defines a photoprinter as a "stand-alone appliance for printing digital photographs onto a printable medium" and that the term "stand-alone" means that the printer "is capable of processing and printing digital files independent of external host device, such as a computer," and the term "processing" means "calculating a pixel pattern to be printed on the printable medium that represents the corresponding digital file." (Specification at pages 5-6.) We find this to be a specific definition of the claimed "photoprinter" which the examiner is required to consider when interpreting the claimed invention.

The examiner responds to appellants' argument by repeatedly using the term "print system." (Answer at page 9 et seq.) We find this to be a misinterpretation of the specific limitations of the properly claimed invention. Appellants have repeatedly clarified that the photoprinter is a stand-alone appliance, not a modular system of

components using a computer external to the photoprinter that affixes the image to the medium. Clearly, Itoh teaches a modular system where the controller 14 is separate from the printer 16 and monitor 18. (Itoh Figures 1 and 2.)

Here, we find the examiner's application of a modular component system of Itoh to the unitary/stand-alone singular appliance of the claimed invention to be inconsistent with appellants' definition of "photoprinter." The examiner continually uses the term "print system" rather than the claim terminology "photoprinter." We interpret the examiner's terminology to mean that it is close enough to the claimed invention since all the claimed functionality is taught in Itoh, but it is not in the same box or unitary/stand-alone singular appliance. This is not sufficient under 35 U.S.C. § 102 since each and every element as set forth in the claim is not found, either expressly or inherently, in a single prior art reference. Therefore, Itoh does not anticipate the invention as recited in independent claim 1, and its dependent claims, as properly interpreted in light of the specific definitions set forth in the specification. Similarly, Itoh does not anticipate the invention as recited in independent claims 10 and 17 and their dependent claims.

While we find the teachings of Itoh do not anticipate the claimed invention, we find no alternative analysis of the teaching of Itoh under 35 U.S.C. § 103. The examiner has made no findings or conclusion regarding the obviousness of combining these functional units into a single stand-alone appliance/photoprinter nor has the examiner

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applied a reference which would have suggested to combine these functional units in the same housing. Therefore, we make no determination relative to the obviousness of the invention recited in independent claims 1, 10, and 17.

35 U.S.C. § 103

With respect to the obviousness of dependent claims 2 and 6, the examiner relies on the additional teachings of Chang and Levine to teach the additional limitations of these dependent claims and summarily finds these related teachings to suggest modification of the base teachings of Itoh. Here, the examiner has identified no teaching in either reference which remedies the deficiency noted above in the teaching of Itoh. Therefore, we cannot sustain the rejection of dependent claims 2 and 6.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3-5, and 7-20 under 35 U.S.C. § 102 is reversed, and the decision of the examiner to reject claims 2 and 6 under 35 U.S.C. § 103 is reversed.

REVERSED


LEE E. BARRETT
Administrative Patent Judge


JOSEPH F. RUGGIERO
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge

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